

## **REMARKS**

The following issues were raised by the Examiner:

- A. Withdrawal of Claims 16 and 24-29
- B. Drawings
- C. 35 USC 112, second paragraph

Each of these issues is addressed below in turn.

### **A. Withdrawal of Claims 16 and 24-29.**

The Examiner has withdrawn Claims 16 and 24-29 on the grounds that “[u]ntil all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.” (Office Action, p.2). Applicants disagree, however, in order to further prosecution and expressly reserving the right to prosecute the same or similar claims. Claims 16 and 24-29 have been withdrawn.

### **B. Drawings**

The Examiner has made certain objections concerning Figures 15 and 17. It should be repeated that the formal drawings did not introduce changes, but the PAIR system reveals that the scanning department at the PTO cut off the bottom of these pages. The Applicant has resubmitted, the originals. Since the Examiner is requesting a new statement on these originals of “Replacement Sheet,” the Applicant is doing so for Figures 15 and 17.

### **C. 35 USC 112, second paragraph**

The Examiner has rejected independent claims 1 and 9 for allegedly violating 35 USC 112, second paragraph. Specifically, the Examiner argues that the term “corresponding to” creates a claim that is indefinite. We disagree. A claim is indefinite when read in light of specification, the claim does not reasonably apprise those skilled in the art of the scope of the invention. Howmedica Osteonics v. Tranquil Prospects (Fed Cir 2005). However, the claims term must be so insolubly ambiguous that no narrowing construction can properly be adopted. When a claim “is not insolubly ambiguous, it is not invalid for indefiniteness.” Bancorp v.

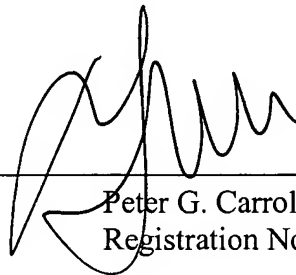
Hartford Life, 359 F.3d 1367, 1372 (Fed. Cir. 2004). Here, the Examiner admits that the claim term “corresponding to” has meaning. Example 22 on page 115 of the specification exemplifies one embodiment. The definiteness of claim terms depends on whether those terms can be given any reasonable meaning and a claim is not indefinite merely because its scope is not ascertainable from the face of the claims. Datamize v. Plumtree Software (Fed. Cir Aug. 2005) and Amgen v. Hoechst (Fed. Cir. 2003). In any case, in no way acquiescing to the rejection, but to further prosecution, hereby expressly reserving the right to prosecute the same or similar claims, the Applicant has amended claim 1 and 9 so they recite that the T7 promoter and ribosomal binding site are oligonucleotide sequences. Antecedent bases for “regions of complementarity” has been amended in the claims by expressing a “first region” and a “second region” in claims 1, 4, 5, 6, 9, 11, 12, and 13.

### CONCLUSION

The Applicant believes that the arguments and amendments set forth above traverse the Examiner's rejections and therefore, request that all grounds for rejection be withdrawn for the reasons above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicant encourages the Examiner to call the undersigned collect at 617.984.0616.

Date: March 20, 2007

By: \_\_\_\_\_



Peter G. Carroll  
Registration No.: 32, 837

**MEDLEN & CARROLL, LLP**  
101 Howard Street, Suite 350  
San Francisco, CA 94105